

REMARKS

In the Office Action¹, the Examiner rejected claims 1-30 under 35 U.S.C. § 101 as being purportedly directed to non-statutory subject matter; and rejected claims 1-30 under 35 U.S.C. § 103(a) as being purportedly unpatentable over International Publication No. WO 01/18674 to Maloney et al. ("*Maloney*") in view of U.S. Patent No. 4,122,947 to Falla ("*Falla*").

Rejection of Claims 1-30 under 35 U.S.C. § 101

Applicants respectfully traverse the rejection of claims 1-30 under 35 U.S.C. § 101 because the claims produce a useful, concrete, and tangible result.

The Examiner appears to allege that Applicants' claims fail to meet the "concrete" prong of the patentability test of *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1998). See Office Action, p. 3. The Examiner alleges the following:

The claims, as currently recited, appear to be directed to nothing more than asking a subject *personal questions*, and, based on the received *answers to the personal questions* selecting from a plurality of testing materials at le[a]st one customized set of testing material. . . . The answers received for such types of questions are clearly subjective, and would differ from subject to subject, thereby providing no indicating [*sic*] of concreteness of the result. Accordingly, the claimed invention does not appear to provide concrete result and is, therefore, deemed to be non-statutory."

Office Action, p. 3 (emphasis in original). Applicants respectfully disagree.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Contrary to the Examiner's assertions in the Office Action, answers to the types of "questions" recited in independent claims 1, 11, 20, and 24 are not "clearly subjective" and, in some examples, could relate to objective criteria. Regardless, even if answers to some of the questions were to have subjective criteria, the claims would still provide a concrete result. For example, each of independent claims 1, 11, 20, 24, and 25 includes recitations relating to "selecting . . . at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject."

The recited selection of one or more customized sets of testing materials is not random or haphazard. In fact, the "selecting" is "based on the received answers," as recited in claims 1, 11, 20, and 24, or "based on the received information," as recited in claim 25. According to some of the examples described in Applicants' specification, "[i]dentifying the at least one physical self-test may be accomplished using a selection algorithm, the selection algorithm evaluating the first response set [e.g., received answers] to select at least one physical test." Specification, p. 26, para. [064]. In an exemplary embodiment, "[u]sing the database, the algorithm may compare subject provided information [e.g., received answers] with the stored correlation data." Specification, p. 23, para. [058]. "For example, if the subject indicates a dry skin condition in the first response set, the selection algorithm may select test materials, such as d-squame disks, that determine a level of skin dryness, rather than test materials, such as sebutape, that determine a level of skin oiliness." Specification, p. 26, para. [065]. Furthermore, "the selection algorithm for identifying the physical

self-test may employ artificial intelligence, a decision tree, or any other type of logic.”
Specification, p. 27, para. [067].

Accordingly, the recited “selecting” is substantially repeatable and predictable, and thus produces a concrete result. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-30 under 35 U.S.C. § 101.

Rejection of Claims 1-30 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-30 under 35 U.S.C. § 103(a) as being purportedly unpatentable over *Maloney* in view of *Falla*, because a *prima facie* case of obviousness has not been established. In particular, the Office Action does not set forth a *prima facie* case of obviousness because, among other things, *Maloney* and *Falla*, taken alone or in combination, do not teach or suggest each and every feature of Applicants’ claims.

For example, independent claim 1 recites, among other things, “based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing materials.” The Examiner apparently asserts that *Maloney* at page 9, lines 7-9 teaches this feature of claim 1. Office Action, p. 4. Applicants respectfully disagree.

Maloney discloses that “the collection of profiling data about a consumer comprises providing the consumer a test kit” and that “the test kit might comprise one or more tests to determine physiological conditions.” *Maloney*, p. 11, lines 6-9.

Although *Maloney* refers to providing a test kit to a consumer, *Maloney* does not teach or suggest a “customized” set of testing materials being selected “**based on** the received answer,” as recited in claim 1 (emphasis added). *Maloney* does not describe

the test kit as being customized, and *Maloney* lacks any disclosure of a set of testing materials being selected based on any received answer or other received information.

For at least the reasons given above, *Maloney* does not teach or suggest “based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing materials,” as recited in claim 1. *Falla* fails to cure the deficiencies of *Maloney* at least because *Falla* also does not teach or suggest the above-quoted features of claim 1. Accordingly, *Maloney* and *Falla*, taken alone or in combination, fail to teach or suggest each and every feature of claim 1.

In addition, independent claims 11, 20, 24, and 25, although different in scope, include recitations having at least some similarity to the above-noted recitations of claim 1. For example, each of claims 11, 20, and 24, recites “based on the received answers, selecting . . . at least one customized set of testing materials,” and claim 25 recites “based on the received information, selecting . . . at least one customized set of testing materials.” *Maloney* and *Falla* fail to teach these features of claims 11, 20, 24, and 25 for at least reasons similar to those given above with respect to claim 1. Also, dependent claims 2-10, 12-19, 21-23, and 26-30 are allowable over *Maloney* and *Falla* at least by virtue of their dependence from allowable base claims 1, 11, 20, 24, and 25. Therefore, a *prima facie* case of obviousness has not been established with respect to claims 1-30. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-30 under 35 U.S.C. § 103(a).

Conclusion

Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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